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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,589	02/21/2002	Richard G. Morton	2001-0122-1	2835

7590

09/08/2003

WILLIAM C. CRAY  
CYMER, INC.-LEGAL DEPT.  
17075 THORN MINT COURT  
San Diego, CA 92127

EXAMINER

TALBOT, BRIAN K

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 09/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/081,589

Applicant(s)

MORTON ET AL.

Examiner

Brian K Talbot

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other:  |

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1. The pre-amendment filed 6/26/03 has been considered and entered. Claims 1-23 and 30-37 have been canceled. Claims 24-29 remain in the application.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 24, the phrase “for use in a laser” is unclear. Applicant is reminded that “intended use” is not a limitation for claimed subject matter. In addition, the terms “fabricating” and “creating” are vague and indefinite as the claims fails to recite how these processes are performed.

With respect to claim 25, the claim is unclear. The Examiner questions how “operating the electrode ...” would create a porous layer? The process steps in forming this layer need to be claimed (see claim 27).

With respect to claim 27, the claim is unclear. The Examiner questions how “mixing insulating particles and molten metal...” produce a discharge section of the electrode? Is the “mixture” applied to a substrate to form the electrode? Is the “mixture” molded? Clarification is requested.

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With respect to claims 28-29, the term "dimensions" is unclear. What does the term "dimension" encompass? Diameter? Height? Width? Clarification is requested.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otto et al. (3,828,277), Dvorkin (5,771,259) or JP 01-154,577.

Otto et al. (3,828,277) teaches a capacitor discharge laser whereby the electrode is coated with a ceramic dielectric layer (abstract).

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Dvorkin (5,771,259) teaches a laser electrode coating whereby a dual layer of materials is applied to the electrode. The dual layer comprises a catalyst layer and a dielectric layer. (see abstract).

JP 01-154,577 teaches a mica coating layer around an auxiliary electrode for a discharge laser (see constitution).

Otto et al. (3,828,277), Dvorkin (5,771,259) or JP 01-154,577 all fail to teach an “elongated” electrode with a length of at least 50 cm and a width of 3 cm.

While the Examiner acknowledges this fact, it is the Examiner’s position that “elongated electrodes” are conventional in the art concerning laser discharge devices. Hence, the claimed dimensions would have been an obvious modification of the prior art as well as the fact that one skilled in the art would have optimized the dimensions of the electrode depending upon the desired end product.

With respect to the claims 26 and 28, the process of applying particles of a coating material to form a layer is commonplace in the art and would have been expected to produce the similar results regardless of the technique utilized.

#### ***Allowable Subject Matter***

5. The following is a statement of reasons for the indication of allowable subject matter. The prior art fails to teach matter:


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6. Claims 27 and 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Monday-Friday 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.

  
Brian K Talbot  
Primary Examiner  
Art Unit 1762

BKT